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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1046_023	
	Application Number 10/604,118	Filed June 26, 2003	
	First Named Inventor Ray D. Heineman, et al.		
	Art Unit 2627	Examiner T. Chen	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,551</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34.</p> <p> Signature Kenneth Altshuler Typed or printed name (315) 425-9000 Telephone number 10/10/06 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</p>			

Pre-Appeal Brief Request for Review	
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Dated: <u>10/11/06</u>	Signature: <u>Cynthia Losurdo</u> (Cynthia Losurdo)



Express Mail No.: EV676908070US

Attorney Docket No.: 1046_023

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Heineman, Ray D.; Guleff, Samuel J.
Confirmation No.: 1117
Serial No.: 10/604,118 Art Unit: 2627
Filed: June 26, 2003 Examiner: Tianjie Chen
Customer No.: 20874
Title: MAGAZINE-BASED DATA CARTRIDGE LIBRARY

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Cynthia L. Losurdo
Cynthia L. Losurdo

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Advisory Action mailed on September 11, 2006 ("the Advisory Action"), Applicant requests that the Panel's objective review will conclude that all the outstanding issues, some being reiterated herein summarily, are not bona fide matters for appeal, but rather are issues that clearly should be resolved in Applicant's favor based upon the record. Please enter the following remarks as Applicant's bases for filing this Pre-Appeal Brief Request for Review.

IT IS CLEAR ERROR THAT THE EXAMINER HAS PREMATURLY IMPOSED FINALITY AFTER THE FIRST OFFICE ACTION AND HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF OBVIOUSNESS BOTH BY FAILING TO FIND ANY TRUE CORRESPONDENCE BETWEEN ELEMENTS IN THE PRIOR ART SYSTEMS AND THOSE IN THE CLAIMS AND BY FAILING TO SUBSTANTIATE A REASONABLE MOTIVATION TO COMBINE AND MODIFY THE PRIOR ART REFERENCES

Rejection of claims 1 and 56-58 under § 103(a) over U.S. Patent No. 5,442,500 to Hidano et al. (hereinafter referred to as "Hidano") in view of U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri"):

As an initial matter, Applicant raised to the Examiner's attention that the finality of the Final Office Action of July 12, 2006 (hereinafter referred to as the "Final Office Action")

was inappropriate because, in accordance with the MPEP 706.07(a), second or subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims or based on information contained in an information disclosure statement filed during a period set forth in 37 CFR 1.97(c). Claim 1 was initially rejected on a § 102(b) to Hidano and then finally rejected on a § 103(a) over Hidano in view of Dimitri. Applicant did not make substantive amendments to claim 1 in the response of February 2, 2006; nor did Applicant file an information disclosure statement with the references relied upon in making the currently pending rejection. Applicant brought this error to the Examiner's attention and sought to have the "final" status removed, however, the Examiner has failed even to comment upon this issue and has maintained the finality of the rejections. **See Applicant's Response After Final filed 8/29/2006, ppg. 14.**

The Examiner has failed to properly construe the references in relation to independent claim 1. For example, the Examiner's construction of Hidano's device relative to the Applicant's claimed invention consists of elements that hardly correspond. For example, Hidano's magazine rack 2b uses magazines 30 as loadable slots forming a cassette shelf system that is an extension of the shelf system 2a, see FIG. 5. In other words, the magazines 30 are the shelves which Hidano describes in Column 5, lines 3-19:

"As shown in FIG. 5, the arrayal pitch between the adjacent ones of the cartridges 10 to be loaded in each magazine 30 is set equal to that between the adjacent ones of the cartridges 10 to be accommodated in the main racks 2a, 2a which adjoin the magazine rack 2b. Besides, as shown in FIG. 3, the magazine rack 2b is so constructed that the access plane thereof confronting the side of the transport device 80 is even with the access planes of the main racks 2a, 2a confronting the same. Accordingly, the transport device 80 can deal with the cartridges 10 equally without especially distinguishing the cartridge 10 loaded in the magazine 30 inserted in the magazine rack 2b and the cartridge 10 accommodated in the main rack 2a, so that the operation control of the transport device 80 can be performed with ease."

Claim 1 contrastingly recites "said magazine transport device can move one of said data cartridge magazines between said interior space and said shelf of said shelf system."

Further, the Examiner initially asserts, in the Final Office Action, that Applicant's magazine transport device corresponds to Hidano's drawer 52 for moving a magazine within the library: "Hidano et al. shows a magazine-based data cartridge library in Fig. 2

including... a magazine transport device 52, located within the cabinet, for moving a data cartridge magazine within a portion of an interior volume defined by the cabinet.” Then the Examiner contradicts this assertion by contending that “Hidano et al does not show [and cannot show] that the magazine transport device moves the data cartridge magazine within a portion of an interior volume defined by the cabinet; and the magazine transport device so that the magazine transport device can move a data cartridge magazine between the space and the shelf of the shelf system.” The Examiner attempts to remedy the deficiencies of Hidano relative Applicant’s claimed invention by haphazardly trying to draw correspondence between certain elements found in Dimitri with those found in Hidano. In so doing, the Examiner has related elements that do not correspond in either function or purpose, such as Dimitri’s magazine transport device with Hidano’s drawer or Dimitri’s magazine with Hidano’s significantly different magazine, for example.

Moreover, the Examiner has failed to carry his burden of making a *prima facie* showing that one of ordinary skill in the art would have been motivated to combine the relevant disclosures of Hidano and Dimitri. The Examiner offers only an unsupported conclusory rationale for finding a motivation to combine Hidano with Dimitri: “One of ordinary skill in the art would have been [motivated to] modify the magazine transport device as taught by Dimitri to speed up processing” (**ppg. 3 of the Final Office Action and ppg. 2 of the Advisory Action**). Such a rationale is hardly the “thorough and searching” factual inquiry required to support the Examiner’s combination of the teachings of the references, especially since Hidano and Dimitri are at least directed entirely to solving different problems in relation to their disclosed systems. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Examiner fails to appreciate that unlike Dimitri’s system, both Hidano’s system and Applicant’s disclosed invention are not trying to speed up processing. Hence, the Examiner’s contention that there is a motivation to combine the teachings of Dimitri and Hidano because they are designed “to speed up processing” is simply incorrect.

With regard to independent claim 56 and dependent claim 57, again the Examiner has failed to substantiate the requisite *prima facie* case of obviousness because the cited references neither, alone nor in combination, teach or suggest all of the features as recited in independent claim 56 and dependent claim 57. In addition to the deficiencies of the Examiner’s prior art rejection concerning claim 1, the Examiner failed to provide a clear and

consistent analysis of claims 56 and 57 relative to claim 1, which the Examiner characterizes as “the above constructed device” in his Final Office Action. For example, Applicant recites, “a magazine transport device capable of transporting within said interior space one of said magazines from said shelf system to a position for a cartridge transport to move at least one data cartridge from said data cartridge magazine to a cooperating relationship with said first drive; and an entry/exit port capable of receiving one of said magazines from outside said interior space wherein said magazine transport device is capable of moving said magazine within said interior space to said shelf system.” Claim 57 narrows the magazine transport device to being robotic. Because the Examiner relies on the analysis of claim 1 as the basis for rejecting claims 56 and 57 (“the above constructed device”), Hidano’s drawer cannot correspond to Applicant’s magazine transport because Applicant’s transport is capable of transporting a magazine within the interior space, whereas Hidano’s drawer is not. In addition, Dimitri does not teach, show or suggest moving a magazine from an entry/exit port to a shelf system within the interior space. Furthermore, the Examiner states with respect to claim 57 that the magazine transport device is “inherently robotic” in the “above constructed device” which is inconsistent with the Examiner’s assertion that Hidano’s non-robotic drawer is analogous to Applicant’s magazine transport device. Applicant presumes that the Examiner is relying upon the same argument for the motivation to combine the references to reject claims 56 and 57 as the Examiner used for claim 1. Hence, like claim 1, the motivation to combine is hardly the “thorough and searching” factual inquiry required to support the Examiner’s combination of the teachings of the references, especially since Hidano and Dimitri are directed entirely to solving different problems relative to their disclosed systems.

With regard to independent claim 58, the Examiner once again failed to substantiate the requisite prima facie case of obviousness because the cited references neither, alone nor in combination, teach or suggest all of the features recited in independent claim 58. In addition to the deficiencies as discussed in conjunction with claim 1, the Examiner failed to provide a clear and consistent analysis of claim 58 relative to claim 1, which the Examiner again characterizes as “the above constructed device” in his Final Office Action. For example, Applicant recites, “an entry/exit port capable of receiving one of said magazines into said interior space from outside said interior space wherein said magazine is movable within said interior space to said shelf system by a magazine transport device confined to said

interior space.” Nowhere does either Dimitri or Hidano disclose, teach or suggest a magazine being moved within an interior space by a magazine transport device from an entry/exit port to a shelf system. Also, again to the extent the Examiner is relying upon the alleged motivation to combine the two references as articulated with respect to claim 1, such motivation does not exist, as Applicant has explained above.

Applicant has submitted that the Examiner’s combination of Hidano in view of Dimitri would not have rendered the Applicant’s claimed invention obvious because certain features of Applicant’s claimed invention are not present in the references, certain purportedly corresponding elements are inapposite, and there is no motivation to combine the teachings of the references because they are directed to solving very different problems. For at least the forgoing reasons, the Examiner’s rejections cannot stand and the application should be allowed to issue.

Applicant requests that the Pre-Appeal Board allow the pending claims.

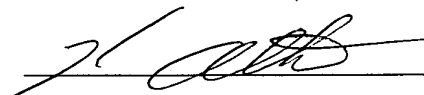
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Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-0289.

Respectfully submitted,

Dated: 10/10/06


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